Xerox Docket No. D/A1201

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Victoria M. BELLOTTI et al.   Group Art Unit: 2145

Application No.:   09/683,532   Examiner: A. CHOUDHURY

Filed: January 16, 2002   Docket No.:   110143

For: SYSTEMS AND METHODS FOR INTEGRATING ELECTRONIC MAIL AND
       DISTRIBUTED NETWORKS INTO A WORKFLOW SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is attached. Applicants respectfully request review of the Final

Rejection mailed February 7, 2007 regarding the above-identified application in light of the

following remarks. Claims 1-22 and 25 are pending in this application. All of the pending

claims are rejected. This review is requested for the following reasons.

I.   **Specific Features Recited in the Pending Claims are Neither Taught, nor Would
       They Have Been Suggested, by the Applied Prior Art Reference**

The Office Action rejects claims 1-22 and 25 under 35 U.S.C. §103(a) over

"Implementation of a Workflow-based Web Application with an Electronic Signature

Mechanism" by Kim et al. (hereinafter "Kim").

Regarding claims 1 and 10, the Office Action asserts that Kim teaches a method for

transmitting workflow-enabled electronic mail messages from a user of a workflow system to

a recipient, in which the recipient does not have access to the workflow system. This assertion is incorrect for at least the following reasons.

The recipients of Kim have access to the workflow system. The Office Action, on page 3, concedes that Kim does not explicitly recite that the recipient does not have access to the workflow system prior to receipt of the e-mail, and notes that Kim teaches that only authenticated users can access the documents. The Office Action relies on Official Notice to assert that, therefore, "means are present within Kim's design for creating an email to the recipient who does not have access to a workflow system." The Office Action's reasoning is based on the erroneous interpretation that having access to the workflow system is the same as access to an associated process of the workflow system. These different access capabilities are distinctly claimed in claims 1 and 10. The recipients in Kim have access to the workflow system since they are registered users of the given Virtual Private Network (VPN) (see page 2, left column, line 3; page 2, right column, last paragraph; page 3, left column, last paragraph; page 4, left column, last two paragraphs; page 4, right column, third paragraph). Further evidence of this is demonstrated by Kim's electronic signature mechanism. Each of the three signature submodules, described on page 4, restricts access based on the unique e-mail addresses and passwords of the users.

This equation of access to a document within the workflow system and access to the workflow system is obviously incorrect and does not correspond with the features of the pending claims. Applicants have distinctly recited a recipient who does not have access to a workflow system, and providing access to a document within the workflow system, as separate features. The users in Kim have access to the workflow system via their authenticated e-mails and passwords regardless of going through a particular URL within an e-mail. The Office Action's assertion that, prior to clicking on the URL, the user has no access to the workflow system is not supported by the reference.

With regard to claims 4, 5, 13 and 14, the Office Action asserts that Kim teaches randomly or pseudo-randomly generating the network address. This assertion is incorrect. Kim does <u>not</u> address the relevant network addresses being <u>generated</u>. The section upon which the Office Action relies merely states that a linked URL, which is the location of the document in the system, is included in an e-mail. The Office Action goes on to refer to a section in Kim that deals with generating <u>an electronic signature key</u> as teaching the generation of network address. This assertion is also incorrect. The generating of the electronic signature key described in Kim does not correspond to generating a network address.

Regarding claims 8, 9, 19 and 20, the Office Action concedes that Kim does not teach embedding multiple links within a single e-mail. The Office Action relies on Official Notice that is well known in the art that a plurality of links can be embedded in an e-mail for the purpose of sending multiple links without using multiple messages. However, as detailed in the July 13, 2006 Amendment, the November 8, 2006 personal interview with the Examiner, and the November 16 Amendment, such a modification of Kim would impermissibly alter Kim's <u>method of operation</u> and render it <u>unsuitable for its intended purpose</u>. Specifically, Kim teaches sending decision makers individual e-mails, specific to certain documents, with individual random keys. As such, careful control of the sequence of approval is achieved (see section 3.3 of Kim). Incorporating multiple links to various stages of the workflow process of Kim, with all of the corresponding random keys required by Kim, would defeat this purpose, rendering the invention of Kim unsuitable for its intended purpose.

The Office Action misconstrues the above argument by asserting that, merely because Kim is capable of supporting such a feature, that it would have been obvious to one of ordinary skill in the art to modify the reference to include such plurality of links. The Office Action then asserts, with no reference to law or regulation, that because embedding a plurality

of links "is not impossible" this somehow negates Applicants' argument that such a modification of Kim would impermissibly alter Kim's method of operation and render it unsuitable for its intended purpose. This is not the applicable standard. The Office Action does not, therefore, establish a *prima facie* case for combining the references in the manner suggested.

Regarding claim 25, the Office Action asserts that Kim teaches excluding generating network addresses that have been embedded in previous e-mail messages created by the system that have not yet been accessed. The Office Action relies on page 2, second column, lines 25-40 of Kim as teaching such a feature. In the Remarks section, the Office Action asserts that because Kim teaches that data within an e-mail, including the URL, can be encrypted to prevent it from being exposed, this means that the URL within each e-mail is "unique." This assertion is incorrect and does not address the relevant features of claim 25. For example, the fact that information may be encrypted for transmission, and decrypted for use, does not mean that URLs within each e-mail are unique. For example, if the same URL were sent to several users via encryption, even though each message might contain different encrypted data, the URL may be the same. Moreover, this does not correspond to excluding generated network addresses that have previously been embedded in any previous e-mail messages created by the system that have not yet been accessed. The feature of claim 25 allows for network addresses that have been accessed to be used again. There is no teaching or suggestion in the applied prior art reference of excluding generated network addresses that have previously been embedded in any previous e-mail messages created by the system that have not yet been accessed.

II.   Conclusion

In summary, Kim does not teach, nor can it reasonably be considered to have suggested, the combinations of all of the features positively recited in at least independent

claims 1, 10 and 21. Further, claims 2-9, 11-20, 22 and 25 are also neither taught, nor would they have been suggested, by the applied prior art reference for at least the respective dependence of these claims, directly or indirectly, on allowable independent claims 1 and 10, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicants respectfully request that the Review Panel review the substance of the February 7 Final Rejection in light of the above remarks. Applicants believe that upon such review, the Review Panel will determine that a *prima facie* case for obviousness of the subject matter of pending claims over Kim has not been established. In this regard, favorable reconsideration and prompt allowance of claims 1-22 and 25 are earnestly solicited.

Should the Review Panel believe that anything further would be desirable in order to place this application in an even better condition for allowance, the Review Panel is invited to contact Applicants' undersigned representative.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

James E. Golladay, II
Registration No. 58,182

JAO:JEG/gml

Attachment:
    Notice of Appeal

Date: March 30, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400